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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,865	10/01/2004	Migaku Suzuki	120904	2855

25944 7590 12/04/2006

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,865

Applicant(s)

SUZUKI ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/11/05, 4/17/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1 the applicant recites the closed preamble language of "consisting of". This language excludes the claims from containing any additional element, step or ingredient not specified in the claim. This is in direct contrast to the language in line 2 reciting "two or more super-absorbent sheets". This implies that additional layers can be included when the applicant has already used the restrictive term "consisting of" in the claim. Additionally, claims 4, 6, 8, 11 and 13 all appear to add additional elements to the claims which would be excluded by the "consisting of" limitation. See MPEP 2111.03. Since the language drawn to "consisting of" is used in the claim the examiner will attempt to apply art to the claims as they read with the restrictive preamble.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either JP 63-256701 or JP 6-58931 cited by the applicant.

Both references disclose two absorbent layers with a hydrophilic non-woven sheet there between. This is the embodiment of claims 8 and 11 which define the channel member there as in claim 1. Refer to absorbent layers 4,7 and non-woven layer 5 there between in JP 63-256701. Refer to absorbent layers 2,4 and non-woven layer 3 there between in JP 6-58931. The above references do teach other elements than recited by

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the applicant. However, the examiner is attempting to apply prior art as discussed above in the 35 USC 112 rejection.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to eliminate the additional elements and there intended function since it has been held to be within general skill of a worker in the art to eliminate an element or its function as a matter of obvious design choice. See *In re Karlson*, 136 USPQ 184 (CCPA 1963). With regards to claim 13, an impervious layer is disclosed on page 5, lines 6-10 of the translation supplied by the applicant.

7. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either JP 63-256701 or JP 6-58931 cited by the applicant as applied to claims 1, 8, 9 and 11-13 above, and further in view of the applicant's discussion of the prior art (ADPA) and Ahr et al (4323069).

The primary reference teaches the invention substantially as recited except for the specific materials of the absorbent layer per claims 2 and 3, the tube per claims 4 and 5 and the undulating sheet per claims 6 and 7. See the 35 U.S.C. 103 rejection above.

From the ADPA on page 14, lines 10-18, it is disclosed that the absorbent layer s are known. Ahr et al discloses an undulating sheet with apertures (sheet 40) therein in known to distribute fluids to an absorbent core 16 per claims 6 and 7.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the combination of the primary references to from the sheet of the recited material and thickness since the applicant discloses these sheets are known in the art. With regards to claims 4 and 5, a tube would be an obvious means

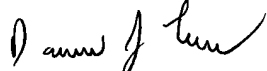
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to distribute the fluids motivated by the fact the prior art recognizes the distribution of fluids is desirable and tubes are known to transport fluid materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
11/27/06